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MCI, INC
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW, 10TH FLOOR
WASHINGTON, DC 20036

EXAMINER

NGUYEN, STEVEN H D

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2665

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/294,475
Filing Date: April 20, 1999
Appellant(s): GATESMAN, KEVIN

Margo Livesay
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/30/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-29 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 2665

(9) Prior Art of Record

6,515,996	TONNBY	2-2003
6,456,625	ITOI	9-2002
6,449,251	AWADALLAH	9-2002
6,067,353	SZELIGA	5-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-3, 6-7, 9-15, 17-18 and 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonnby (USP 6515996) in view of Itoi (USP 6456625).

Tonnby discloses (Figs 1-9 and col. 1, lines 5 to col. 10, lines 60) apparatus for enabling more than one communicative process to be carried on at the same time over a subscriber line comprising a network interface means for connecting to a circuit switched telephone network (Fig 8, Ref 70 for connecting to PSTN); a telephone interface means for connecting to at least one telephone, wherein the telephone interface means is adapted to patch a call from the one telephone to the circuit switched telephone network via the network interface means upon a determination that no data connection is established to the circuit switched telephone network (Fig 8, Ref 71 for establishing a telephone call via PSTN if PC does not established with a service provider); a computer interface means for connecting to at least one computer (Fig 8, Ref 74); and a routing means for selectively routing voice and data signals from said telephone and said computer to and from said circuit switched telephone network via said subscriber line (Fig

Art Unit: 2665

7, Ref 80); an analog telephone interface, which includes a ring generator, DTMF generator, and dial tone generator (Col 9, lines 12-29); routing means for apportioning the bandwidth of the subscriber line for selectively routing the packet for computer and telephone (the voice packet and data packet is simultaneously multiplexed into the subscriber line, Fig 7, Ref 80). However, Tonnby does not disclose routing means for assigning internal network addresses to said telephone and said computer and routing the voice and data packets according to assigned internal network addresses. In the same field of endeavor, Itoi discloses ((Fig 1-14 and col. 1-22) a routing means for assigning the internal network addresses to a telephone and computer and routing the incoming and outgoing voice or data packet based on the internal network address (Fig 3b, Ref 320 used to give the local IP addresses to data terminal 314 and telephone 311, See col. 8, lines 40-56); a gateway means for packetizing a received voice signal from the telephone interface and depacketizing the received voice signals from routing means via PSTN (col. 9, lines 45-60 discloses a means for packetizing voice signal into a packet or depacketizing voice packet into voice signal); routing means including an address conversion and translation means for translating the respective internal network addresses of the telephone and computer to correspond with an external network address of the subscriber line assigned to communicate with the network and establishing respective connections between the external network address of the subscriber line and the internal addresses of the telephone and the computer so that both voice and data signals can be exchanged between the telephone and said computer connected to the said communication controller and devices communicatively connected to the network (Fig 3b, Ref 307 for using to routing the voice packet); a voice circuit communicatively connected to said telephone and said routing means for receiving and converting digital voice signal routed from

Art Unit: 2665

the routing means into analog voice signal for telephone and converting and feeding analog voice signals input from the telephone into digital voice signals for the routing means (Fig 3b, Ref 309 for receiving a voice packet from routing means 307 and converting digital voice into analog voice) and mapping the telephone number compatible with PSTN to an internal address (Fig 4 discloses a network address translation table for translating between local and external IP);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a routing means for assigning an internal network address to the devices coupling the interface as disclosed Itoi's system into Tonnby's system. The motivation would have been to increase the number of devices could access to the Internet.

2. Claims 4-5, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonnby in view of Itoi as applied to claims 1, 9 and 17 above, and further in view of Awadallah (USP 6449251).

Regarding claims 4-5, 16 and 19, Tonnby and Itoi fail to disclose the claimed invention. However, Awadallah discloses a method and apparatus for setting a priority to the voice and data packets wherein voice packet has a higher priority than the data packet (col. 1, lines 28-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply an priority means for setting a priority of voice and data packet as disclosed by Awadallah's system into the telecommunication network of Tonnby and Itoi. The motivation would have been to reduce the latency for transmitting the voice packets.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tonnby in view of Itoi as applied to claim 1 above, and further in view of Szeliga (USP 6067353).

Regarding claim 8, Itoi fails to fully disclose the claimed invention. However, Tonnby discloses DTMF generator, ring generator, a visual indicator for message and an alert message for incoming call and call forwarding module for forwarding a call to telephone or the computer (Col. 5, lines 50-62 and Col 9, lines 12-29) and Szeliga discloses a visual call-waiting indicator (Fig 3, Ref 28 and col. 4, lines 24-47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a universal indicator to a subscriber and a visual call waiting indicator as disclosed by Szeliga into the system of Tonnby and Itoi in order to provide an indicator to a deaf person.

(11) *Response to Argument*

In response to Appellant's argument that (1) Tonnby and Itoi do not disclose a routing means for selectively routing voice signals and data signals from said telephone and said computer to and from said circuit switched telephone network using said subscriber line based on said internal network addresses or a logic configured for selectively routing voice and data signals among the telephone and the computer and the circuit switched telephone network over the subscriber line based on said internal network addresses and the external network addresses; (2) a telephone interface means for connecting to at least one telephone wherein the telephone interface means is adapted to patch a call from the one telephone to the circuit switched telephone network vi the network interface means upon a determination that no data connection is established to the circuit switched telephone network; (3) failing to establish a prima facie basis between Tonnby, Itoi and Awadallah; (4) failing to establish a prima facie basis between Tonnby, Itoi and Szeliga; (5) there is no motivation but impermissible hindsight to combine

Art Unit: 2665

Tonnby and Itoi; (6) Tonnby and Itoi are non-analogous art; (7) there is no motivation for modifying Tonnby in view of Itoi; (8) Tonnby and Itoi fail to disclose a gateway means for packetizing voice signals and depacketizing voice signal from the routing means packetized signal being routed by routing means for transmission to the circuit switched telephone network and depacketized voice signals being routed to the telephone interface for establishing a telephone conversation between a caller using said telephone and an other caller connected to the circuit switched telephone network via another telephone as set forth in claims 2, 13 and 23; (9) establishing respective connections between said external network address of the subscriber line and said internal network addresses of said telephone and the computer as set forth in claims 3, 10, 14 and 20; (10) a routing means fails to apportion the bandwidth of the subscriber line as set forth in claims 6, 15 and 18; (11) fail to disclose voice circuit communicatively connected to the telephone and the routing means as set forth in claims 7, 11-12, 21-22 and 24; (12) fail to disclose a gateway means is configured to map a telephone number compatible with the circuit switched telephone network to one of the internal network addresses as set forth in claims 27 and 28; (13) fail to disclose a call forward management module and a message waiting light for informing a user that a voice call has been received and forwarded by the call forwarding management module to the telephone as set forth in claim 8.

With respect to (1), the appellant states that Tonnby and Itoi do not disclose a routing means for selectively routing voice signals and data signals from said telephone and said computer to and from said circuit switched telephone network using said subscriber line based on said internal network addresses or a logic configured for selectively routing voice and data signals among the telephone and the computer and the circuit switched telephone network over

Art Unit: 2665

the subscriber line based on said internal network addresses and the external network addresses. However, the examiner disagrees with Appellant's argument that since Tonnby discloses an IP router (Fig 7, Ref 80) "routing means" for receiving the voice and data signals from a subscriber lines and selectively routing the voice and data signals to its destination such as computer and telephone using Internet protocol (See col. 3, lines 4-8; col. 5, lines 9-19 and col. 9, lines 38-46); Itoi discloses a communication device which comprises an address setting unit assigns a unique internal address for each of telephone and computer and establishing a routing table so that a routing means for selectively routing the incoming voice and data signals according to its internal addresses and external address (See col. 3, lines 36-48 and col. 4, lines 24-30).

With respect to (2), the appellant states that Tonnby fails to disclose a telephone interface means for connecting to at least one telephone wherein the telephone interface means is adapted to patch a call from the one telephone to the circuit switched telephone network vi the network interface means upon a determination that no data connection is established to the circuit switched telephone network. However, the examiner disagrees with Appellant's argument because Tonnby discloses the switches for receiving a call setup from a telephone and determining if the modem does not connect with internet service provider via a circuit switched network, the switches will switch to a location so that the call can be routed to the circuit switched network (Fig 6 and 8, the CPU will determine what modes the modem is activate, active mode "data connection" or de-active mode "no data connection" in order to control the relay to switch the switches; if data connection has been established or not if not the CPU will control Ref 77 and 75 to release the switches to a position to establish a connection between

Art Unit: 2665

telephone and circuit switched network in order to send a call setup message to the circuit switched network).

With respect to (3), the appellant states that the examiner fails to establish a prima facie basis between Tonnby, Itoi and Awadallah. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tonnby discloses a system and method for selectively routing the incoming voice and data signals from a subscriber line to the analog telephone and computer according to the destination IP address of voice and data packets (See col. 3, lines 4-8; col. 5, lines 9-19 and col. 9, lines 38-46). Itoi discloses a method and system for assigning an unique local IP address for each of analog telephone and computer which is coupled to the system in order to selectively route the IP packet to its destination according to its local address (See col. 3, lines 36-48 and col. 4, lines 24-30). Awadallah discloses a method and system for setting a priority for voice and data packet wherein the priority of voice packet is higher than the data packet (col. 1, lines 28-37). Since, it is well known and expected in the art that a voice communication between the telephones is sensitively to a time delay when the packet network used to route the voice packet between the telephones in order to reserve the quality of the voice communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to apply a priority setting unit for setting a

Art Unit: 2665

priority for a voice packet when the voice packet is generated as disclosed Awadallah's system and method into the system and method of Tonnby and Itoi in order to provide a good quality for voice conversation and reduce the latency for transmitting the voice packets between the telephone devices via the packet network.

With respect to (4) and (13), the appellant states that the examiner fails to establish a prima facie basis between Tonnby, Itoi and Szeliga. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tonnby discloses a system and method for selectively routing the incoming voice and data signals from a subscriber line to the analog telephone and computer according to the destination IP address of voice and data packets (See col. 3, lines 4-8; col. 5, lines 9-19 and col. 9, lines 38-46) and a visual indicator for indicating a received incoming mail (col. 8, lines 3) and receiving a incoming call which is forwarded by telephone server; notifying the user of incoming call when the subscriber is surfing Internet so that the subscriber can accept, reject or redirect incoming to a call handler and a call forwarding module for forwarding a call to the telephone or telephone (col. 5, lines 50 to col 6, lines 22, Fig 2, the IP modem forwards the call to either telephone 1 or PC 2, If the subscriber accepts the incoming by picking up the telephone or computer, the incoming call will be forwarded to the telephone or computer in order to establish a conversation between the

Art Unit: 2665

telephone devices). Itoi discloses a method and system for assigning an unique local IP address for each of analog telephone and computer which is coupled to the system in order to selectively route the IP packet to its destination according to its local address (See col. 3, lines 36-48 and col. 4, lines 24-30). Szeliga discloses an audio and visual indicator for indicating an incoming call when the subscriber's modem connected to Internet (Fig 3, 28). Since, Tonnby suggests an audio or message will be used to notify the subscriber before forwarding the incoming call to telephone or computer and a visual indicator (See col. 5, lines 27 to col. 6, lines 23). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a universal indicator to a subscriber and a visual call waiting indicator as disclosed by Szeliga into the system of Tonnby and Itoi in order to provide an indicator to a deaf person.

With respect to (5), the appellant states that the examiner fail to provide a motivation. Therefore, it is impermissible hindsight to combine Tonnby and Itoi. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Tonnby disclose a method and system that includes an IP router for receiving the voice and data packet from a network interface and selectively routing the voice and data packet to its destination based on destination IP address of the IP packet (See col. 3, lines 4-8; col. 5, lines 9-19 and col. 9, lines 38-46). Tonnby does not fully disclose the destination address of IP packet is

Art Unit: 2665

a local IP address or public IP address. Itoi discloses a method and system for assigning an unique local internal address and external address to computer and telephone in order to route the packet via packet network (Fig 3b, Ref 307 is an address setting unit for assigning an local address to each telephone and computer and a routing table 306 is established as figures 4-5 in order to route the voice and data packet to telephone or computer). Since, Tonnby suggests that IP router uses the destination address for routing the voice or data packet to its destination and Internet is public network and LAN is intranet wherein Internet and intranet use Internet protocol for routing packets to its destination (See col. 3, lines 1-8). Furthermore, using a local address for intranet is well known and expected in the art because it provides a security for terminal, reduce the cost to reserve the public IP address from the Internet service provider. Therefore, the combination of Tonnby and Itoi is a proper high sight because Tonnby suggests the devices behind the IP modem can be communicated with each other via intranet via Internet protocol.

With respect to (6), the appellant states that Itoi is a nonanalogous art. In response to applicant's argument that Itoi is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Itoi discloses a telecommunication system that allows a telephone device or computer to establish a communicate with another telephone device or computer and Tonnby discloses a telecommunication system for allowing a telephone device or computer to establish a communicate with another telephone device or compute wherein Tonnby and Itoi are classified in class 370 and sub class 401. Therefore, Itoi is an analogous art with Tonnby.

With respect to (7), The appellant states that there is no motivation for modifying Tonnby in view of Itoi. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tonnby disclose a method and system that includes an IP router for receiving the voice and data packet from a network interface and selectively routing the voice and data packet to its destination based on destination IP address of the IP packet (See col. 3, lines 4-8; col. 5, lines 9-19 and col. 9, lines 38-46). Tonnby does not fully disclose the destination address of IP packet is a local IP address or public IP address. Itoi discloses a method and system for assigning an unique local internal address and external address to computer and telephone in order to route the packet via packet network (Fig 3b, Ref 307 is an address setting unit for assigning an local address to each telephone and computer and a routing table 306 is established as figures 4-5 in order to route the voice and data packet to telephone or computer). Since, Tonnby suggests that IP router uses the destination address for routing the voice or data packet to its destination and Internet is public network and LAN is intranet wherein Internet and intranet use Internet protocol for routing packets to its destination (See col. 3, lines 1-8). Furthermore, using a local address for intranet is well known and expected in the art because it provides a security for terminal, reduce the cost to subscribe the public IP address. When combining the references, the examiner does not suggest that two references are readily

Art Unit: 2665

incorporated into one another to achieve the claimed invention but rather what the references suggest to one of ordinary skill in the art which is teaching how to use a local address as its destination address for routing the packet to its destination as disclosed by Itoi. The motivation would have been to provide a security for terminal, reduce the cost to reserve the public IP addresses from the Internet service provider.

With respect to (8), the appellant states that Tonnby and Itoi fail to disclose a gateway means. However, the examiner disagrees with Appellant's argument because Tonnby discloses gateway means for packetizing or depacketizing voice signal between telephone device and network interface (See col. 4, lines 49-67). Itoi discloses a gateway means for packetizing or depacketizing voice signal between telephone device and network interface (Col. 9, lines 45-60).

With respect to (9), the appellant's states that Tonnby and Itoi fail to disclose a step of establishing respective connections between said external network address of the subscriber line and said internal network addresses of said telephone and the computer. The examiner disagrees with Appellant's argument because Tonnby discloses a telecommunication system for establishing between the telephone device via PSTN and Internet. Itoi discloses a method and system for establishing a voice communication path between telephone devices via Internet by using an local Internet address "private IP address" and external address "public IP address" (Fig 3B, Ref 307).

With respect to (10), the appellant's states that Tonnby and Itoi fail to disclose a routing means for dividing the bandwidth of the subscriber line for voice and data communicating. The examiner disagrees with Appellant's argument because Tonnby discloses the voice and data packets are multiplexing into subscriber line such as 28.8 Kb/s for transmitting to internet or

Art Unit: 2665

using DSVD for multiplexing voice and data packet into subscriber line (Fig 7, Ref 80, the voice packet and data packet is simultaneously multiplexed into the subscriber line. So, the bandwidth of the subscriber line is divided into the portions so that it multiplexes the voice and data packets into the subscriber line).

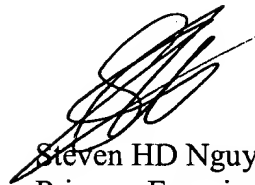
With respect to (11), the appellant's states that Tonnby and Itoi fail to disclose voice circuit communicatively connected to the telephone and the routing means. The examiner disagrees with Appellant's argument that since Tonnby discloses voice circuit communicatively connected to the telephone and the routing means (Fig 7, Ref 75 or 76 for connecting routing means 80 of Fig 7 and telephone Ref 1 of figs 1-2) and Itoi voice circuit communicatively connected to the telephone and the routing means (Fig 3b, Ref 308 for connecting routing means 307 and telephone 311).

With respect to (12), the appellant's states that Tonnby and Itoi fail a gateway means is configured to map a telephone number compatible with the circuit switched telephone network to one of the internal network addresses. The examiner disagrees with Appellant's argument that since Itoi discloses an address setting unit for setting an unique internal address for each telephone having an telephone number which is compatible with the telephone network (Fig 4).

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 2665

Respectfully submitted,



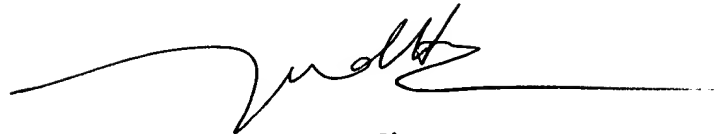
Steven HD Nguyen
Primary Examiner
Art Unit 2665

Steven Nguyen
June 17, 2004

Conferees
Huy Vu
Duc Ho



WORLDCOM, INC.
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW
WASHINGTON, DC 20036



HUY D. VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600